



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,056	09/29/2003	Georges R. Harik	Google-38 (GP-100-00-US)	1182
26479	7590	09/27/2007	EXAMINER	
STRAUB & POKOTYLO 620 TINTON AVENUE BLDG. B, 2ND FLOOR TINTON FALLS, NJ 07724			PADMANABHAN, KAVITA	
			ART UNIT	PAPER NUMBER
			2161	
			MAIL DATE	DELIVERY MODE
			09/27/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding:**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/674,056

Applicant(s)

HARIK, GEORGES R.

Examiner

Kavita Padmanabhan

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,29-33 and 57-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,29-33 and 57-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Status of Claims*

1. Claims 1 and 29 have been amended.
2. Claims 7-28 and 35-56 have been cancelled.
3. Claims 57-66 have been added.
4. Claims 1-5, 29-33, and 57-66 are pending.
5. Claims 1-5, 29-33, and 57-66 are rejected.

### *Continued Examination Under 37 CFR 1.114*

6. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/6/07 has been entered.

### *Claim Rejections - 35 USC § 112*

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
8. **Claims 61 and 66** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claims 61 and 66** recite the trademarked name "page rank", i.e. PageRank.

Per MPEP 2173.05(u), if the trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of the 35 U.S.C. 112, second paragraph. Ex parte Simpson, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name.

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. **Claims 29-33 and 62-66** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a test of whether the invention is categorized as a process, machine, manufacture or composition of matter and if the invention produces a useful, concrete and tangible result. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must produce a useful, concrete and tangible result.

In the instant case, **claim 29** recites an apparatus, however it appears that the claimed means could consist purely of software per se, which is nonstatutory. **Claims 30-33 and 62-66** are similarly rejected.

The examiner will apply prior art to these claims as best understood, with the assumption that applicant will amend to overcome the stated 101 rejections.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. **Claims 1-5, 29-33, 58-60, and 63-65** are rejected under 35 U.S.C. 102(e) as being anticipated by **Rorex et al.** (US 6,876,997, hereinafter “Rorex”).

In regards to **claim 1**, **Rorex** teaches a method for generating information for an online advertisement, the method comprising:

a) generating a first plurality of search results using a search query and an index of advertiser Web page information (**Rorex; col. 4, lines 33-46, 52-58; col. 5, lines 16-31 – “pay for placement database ... contains an ordered collection of search listing records used to generate search results in response to user queries.” – the ordered collection of search**

**listing records used to generate the search results is interpreted to be an index of advertiser web page information);**

b) determining, for each of the first plurality of search results, at least one of (A) landing page information (**Rorex; col. 4, lines 33-46 – “generates a list of HyperText links to documents that contain information relevant to search terms entered by the user” – the document to which the link directs the user is interpreted to be a landing page, and the landing page information, i.e. the link and the associated document/landing page, are determined using the results of the user’s search terms**) and (B) ad creative information using a corresponding one of the first plurality of search results;

c) generating, for each of the first plurality of search results, an ad using the determined at least one of a landing page information and ad creative information (**Rorex; col. 4, lines 33-46, 52-58; col. 5, lines 16-31, 52-57 – the paid search result listings are ads that are used to advertise a particular advertiser’s product to the user, which is why an advertiser pays for placement of their web page in the search result listings, because it serves as an advertisement to attract users to a particular advertiser’s product**); and

d) generating a search result page including

i) at least a second plurality of search results corresponding to the search query (**Rorex; col. 5, lines 58-65; col. 7, lines 35-38**), and

ii) the generated ads (**Rorex; col. 4, lines 33-46, 52-58; col. 5, lines 16-31, 52-57 – “The searcher may click on HyperText links associated with each listing in that search result page to access the corresponding web pages. The HyperText links ...**

**include paid listings to advertiser web pages” – the paid listings to advertiser web pages constitute ads),**

wherein the generated ads are maintained as distinct from the second plurality of search result on the search result page (**Rorex; Fig. 3a; col. 6, line 60 – col. 7, line 8; col. 5, lines 58-65; col. 7, lines 35-38; applicant’s specification at p11, lines 18-20 states “preferably, the search results are maintained as distinct from the ads, so as not to confuse the user between paid advertisements and presumably neutral search results”, and Rorex at col. 5, lines 58-65 states “non-paid listings follow the paid advertiser listings on the search results page”, which clearly meets not only the claimed limitation, but also its stated purpose as per the applicant’s specification; in Rorex, the examiner is interpreting the non-paid listings on the search result page to be the second plurality of search results, which are displayed following the paid listings, i.e. ads, on the search result page and are thereby kept distinct from them).**

**Claims 2-4** are rejected based on their dependency on claim 1. Claim 1 recites, “determining at least one of landing page information and ad creative information,” and the reference teaches determining landing page information, whereas claims 2-4 seek to further limit the determination of ad creative information.

In regards to **claim 5**, **Rorex** teaches the method of claim 1 wherein the landing page information is a URL included in the search result (**Rorex; col. 5, lines 38-45**).

In regards to **claim 58**, **Rorex** teaches the method of claim 1 wherein the first plurality of search results and the second plurality of search results are generated by the same search operations (**Rorex; col. 7, lines 42-43 – same search terms/operators**).

In regards to **claim 59**, **Rorex** teaches the method of claim 1 wherein the ads included on the generated search results page are ordered using a search score (**Rorex; col. 7, lines 12-34**).

In regards to **claim 60**, **Rorex** teaches the method of claim 59 wherein the search score is a function of an information retrieval score (**Rorex; col. 7, lines 12-34**).

**Claims 29-33 and 63-65** are rejected with the same citations given for claims 1-5 and 58-60, respectively.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out



Art Unit: 2161

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. **Claims 57 and 62** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rorex in view of Davis et al.** (US 6,269,361, hereinafter “Davis”).

In regards to **claim 57**, **Rorex** teaches the method of claim 1.

Rorex does not expressly teach the second plurality of search results, i.e. the unpaid listings, being a predetermined number wherein the predetermined number of the second plurality of search results is no less than a number of ads included on the generated search results page.

**Davis** teaches unpaid listings being displayed after the paid listings to fill in the remainder of the 40 available slots in a search results page when there are an insufficient number of relevant paid listings (**Davis; col. 18, lines 26-36**). Therefore, the number of available slots for the unpaid listings is predetermined, based on the determined number of relevant paid listings, prior to displaying the listings.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of **Rorex** by including the teaching of **Davis**, whereby the number of unpaid listings could obviously be equal to or greater than the number of relevant paid listings for any given search in an attempt to ensure that the searcher receives the most complete and relevant search results (**Davis; col. 5, lines 48-50**).

**Claim 62** is rejected with the same citations given for claim 57.

16. **Claims 61 and 66** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rorex**.

In regards to **claim 61**, **Rorex** teaches the method of claim 59.

Rorex does not expressly teach the search score being a function of a page rank score.

However, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to use PageRank to determine the search score in Rorex, since PageRank is a popular and well-known ranking methodology.

**Claim 66** is rejected with the same citations given for claims 61.

#### ***Response to Amendment***

17. Applicant's amendments filed 7/6/07 with respect to the objections to the specification have been fully considered. The corresponding objections have been withdrawn accordingly.

18. Applicant's amendments filed 7/6/07 with respect to the 35 U.S.C. 101 rejections have been fully considered. However, the rejections have been maintained. Applicant argues at page 11 of applicant's remarks that software per se, without the benefit of processor(s) and/or storage devices, could not perform the function recited by the means-plus-function claim elements recited in claim 29. However, the examiner asserts that the processor(s) and/or storage devices are not being claimed and that page 4 of the amended specification filed on 7/6/07 recites in part, "The one or more processors 1010 may execute *machine-executable instructions ... to effect*

*one or more aspects of the present invention*". Therefore, the means recited to implement the invention could clearly consist purely of software per se, i.e. machine-executable instructions, which is not statutory.

### ***Response to Arguments***

19. Applicant's arguments filed 7/6/07 with respect to the prior art rejections have been fully considered but they are not persuasive.

Applicant argues at page 12 of applicant's remarks that Rorex does not teach generating a search result page including (i) a first plurality of ads (generated, for each of a first plurality of search results, using landing page information and/or ad creative information determined from a first plurality of search results) and (ii) a second plurality of search results corresponding to a search query, wherein the generated ads are maintained as distinct from the second plurality of search results on the search result page. The examiner respectfully disagrees and refers the applicant to the rejection above. To clarify, the examiner asserts that Rorex at col. 5, lines 58-65 states "*non-paid listings follow the paid advertiser listings on the search results page*". The examiner is interpreting the non-paid listings on the search result page to be the second plurality of search results, which are displayed following the paid listings, i.e. ads, on the search result page and are thereby kept distinct from them, meeting the language of the claim as written.

***Conclusion***

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kavita Padmanabhan** whose telephone number is **571-272-8352**. The examiner can normally be reached on Monday-Friday, 9:00am-5:30pm.

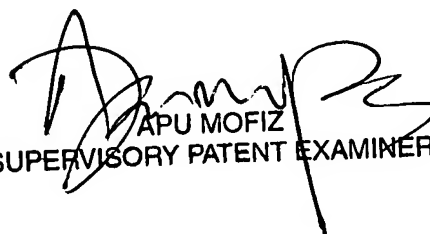
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kavita Padmanabhan  
Assistant Examiner  
AU 2161

*KP*

September 22, 2007

  
APU MOFIZ  
SUPERVISORY PATENT EXAMINER